

### **III. Remarks**

Claims 1-33 are pending in this application. Claims 15-23, 26 are withdrawn as being directed to a non-elected invention. Claims 1-14, 24-25 and 27-33 stand rejected.

#### ***Claim Rejections - 35 USC § 112, first and second paragraphs***

a) Claims 1-14, 24-25 and 27-33 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement in that the specification fails to provide support that any or all known "optically active acids" are applicable in the instant process.

Applicant has amended these claims to recite the optically active acids references disclosed in the specification at page 12, lines 12-18, thus obviating this ground for rejection

b) Claims 1-14, 24-25 and 27-33 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement in that the term R' in claim 1, line 6, is not defined in the specification so as to determine the structures of compounds that are included and/or excluded by the term since the term is defined with the phraseology "such as" on line 15, page 5 of the specification and the listed compounds are deemed examples only.

The examiner acknowledges that by amending the claims to recite the specific optically active acids and compounds represented by R' having support in the specification, the rejection would be overcome.

Applicant traverses this ground for rejection.

First, applicant point out that claims 2 and 3 explicitly state limited definitions of R' reciting the compounds recited in the specification. Thus, these claims and any claims depending from them are not within the scope of this ground for rejection and should be allowable.

With regard to the rejection of claim 1 on the basis the R' is exemplified but not defined in the specification, applicant traverses this ground for rejection.

First, it is noted that the specification does not simply state “R’ is a compound such as ...” Applicant agrees that such wording, without more, would be merely exemplification as stated by the examiner.

But the present specification does not merely provide examples.

The specification clearly states the function of R’ at page 5, lines 14 and 15 where it states “The substituent R’ of the O-substituted hydroxylamine can be whatever substituent, provided that it is inert under the conditions of as Grignard reaction ...” This is a clear definition of the R’ moiety which defines R’ by its function and which clearly states it can be anything that meets the functional requirement. This is more than sufficient guidance to one skilled in the art of Grignard reagents and indicates that the identity of the R’ moiety is unimportant provided it functions in accordance with the requirement that it be inert.

Applicant strongly urges the view that this functional definition is all that is necessary for one skilled in the art and that applicant’s further disclosure, immediately following this functional definition, of exemplification of certain compounds meeting this functional requirement, is non-essential and provides additional guidance only as to preferred useful compounds.

Applicant requests favorable reconsideration of the rejection of claim 1.

The examiner states that, as now amended, claims 1-14, 24-25, and 27-33 lack support in the specification because, according to the specification, page 3, hydroxylamine is reacted formula I in step (a) while 4 fluorophenylmagnesium is reacted with formula III in step (b), and step (c) requires reacting 3-(dimethylamino)propyl magnesium halide with formula (IV) in order to obtain formula (V). However, since when R is H, that is, no substitution, step (c) should be optional because it is not required.

Applicant has amended claim 1 to exclude R as H, thus removing the unsubstituted moiety from the definition. This amendment obviates this ground for rejection.

### **Claim Rejections - 35 USC § 103**

Claims 1-14, 24-25, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guazzi et al., WO 02/48133.

Applicant claims a process of making citalopram from 5-formylphthalide as set forth in steps (a) to (f) in claim 1. In an optional embodiment the H of OH in hydrozylamine (a reagent) can be replaced with any substituent, which is inert under Grignard reaction condition. Applicant also claims enantiomeric separation of formula V or VI with tartaric acid or camphosulfonic acid.

The examiner states that Guazzi et al. teach a similar process of making citalopram (formula I) from 5- formylphthalide and that the substituents R' are taught by Guazzi et al., on page 5, last line to page 6, line 4. the examiner also states that all the reagents in the instant steps are the same as that of Guazzi et al.

Therefore, the examiner concludes that the instant process is no more than a selective combination of the process of Guazzi et al., done in a manner obvious to one of ordinary skill in the art.

Applicant respectfully disagrees.

Contrary to the examiner's argument, the substituents R' are not taught on page 5, last line to page 6, line 4 since Guazzi does not disclose or even remotely suggest the possibility of protecting the oxime.

Thus, since R' is now other than hydrogen, the presently claimed process differs from Guazzi et al in at least two of its features:

1. In Guazzi the oxime is produced in the last but one step of the process whereas in the present process it is produced in the first step

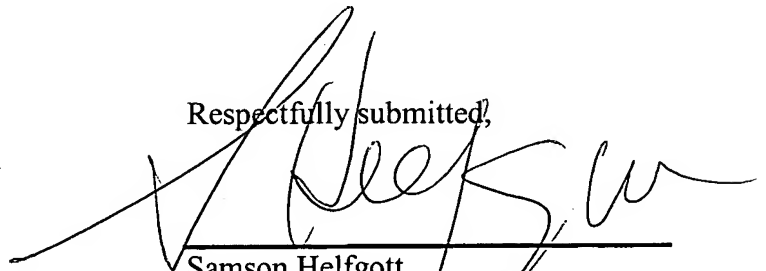
2. Guazzi does not protect the oxime; Guazzi protects intermediate (VIII), formylphthalide.

The consequences of these differences are significant. The yields of the presently claimed process are much higher than those of Guazzi, as can be easily appreciated from the examples.

Therefore, since the prior art does not provide any indication that such an improvement would have been achieved by modifying the process of Guazzi, as done by the present invention, it is respectfully suggested that the Guazzi reference does not establish a *prima facie* case of obviousness.

Any fee due with this paper, not fully covered by an enclosed check, may be charged on Deposit Account 50-1290.

Respectfully submitted,



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